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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,148	03/17/2004	Ronald J. Thompson	Thompson-4C	5032

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EXAMINER	
WEDDINGTON, KEVIN E	
ART UNIT	PAPER NUMBER
1614	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/803,148	THOMPSON ET AL.	
	Examiner	Art Unit	
	Kevin E. Weddington	1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 March 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) *2-13* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 14 and 15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Claims 1-15 are presented for examination.

Applicants' election filed March 20, 2007 in response to the restriction requirement of February 20, 2007 has been received and entered. The applicants elected the species, MENTHOL, without traverse. Claims 1, 14 and 15 will be examined with elected species.

Claims 2-13 are withdrawn from consideration as being drawn to the non-elected invention (37 CFR 1.142(b)).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 14 and 15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 14-18 of U.S. Patent No. 6,702,733 B1. Although the conflicting claims are not identical, they are not

patentably distinct from each other because the only difference between the patented claims and the present claims lies in that in the present claims, an additional agent (5-phosphodiaesterase inhibitor) is administered with menthol.

The present claims would anticipate the patented claims because the patented claims recite, "comprised" and thus opens the claims to the inclusion of additional active agent.

Claims 1, 14 and 15 are not allowed.

Claims 1, 14 and 15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,322,493 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the patented claims and the present claims lies in that in the present claims, an additional agent (5-phosphodiaesterase inhibitor) is administered with menthol.

The present claims would anticipate the patented claims because the patented claims recite, "comprised" and thus opens the claims to the inclusion of additional active agent.

Claims 1, 14 and 15 are not allowed.

Claims 1, 14 and 15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 15-20 of U.S. Patent No. 6,224,541. Although the conflicting claims are not identical, they are not patentably distinct from each other because present application teaches a topical sensitizing combination (A product), and the patented application teaches a method of use

claims containing the instant topical sensitizing combination of the present application therein which makes the method claims of the patented application an obvious variation of the present claims.

Claims 1, 14 and 15 are not allowed.

Claims 1, 14 and 15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 14-16 of copending Application No. 11/105,228. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application teaches a topical sensitizing combination consisting essentially of L-arginine and a cooling agent comprised of menthol and a 5-phosphodiaesterase inhibitor; and the copending application teaches a topical sensitizing combination consisting essentially of L-arginine and a cooling agent comprised of menthol and vardenafil (a 5-phosphodiaesterase inhibitor).

Clearly, the present application's 5-phospodiaesterase inhibitor encompasses the copending application's vardenafil (a specific PDE5 inhibitor).

Claims 1, 14 and 15 are not allowed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled

in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 14 and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This is a written description rejection.

Claims 1, 14 and 15 described compounds that are 5-phosphodiaesterase inhibitors. The instant claims cover all compounds having the pharmaceutical property of being a 5-phosphodiaesterase inhibitor. Describing a compound by its functions will not substitute for written description of the structure of the compound. The invention should be described in such a way as to described what the invention is, not what the invention does. Describing the function of a compound fails to distinguish the compound from other molecules or agents that can perform the same functions.

Undue experimentation is a conclusion reaches by weighing the noted factual considerations set forth below as seen in In re Wands, 858 F. 2d 731, 737, 8 USPQ2d 1400, 1401 (Fed. Cir. 1988). A conclusion of lack of enablement means that, based on the evidence regarding a fair evaluation of an appropriate combination of the factors below, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation.

The factors include:

1) the quantity of experimentation necessary

2) the amount of direction or guidance provided

3) the presence or absence of working examples

4) the nature of the invention

5) the state of the art

6) the relative skill of those in the art

7) the predictability of the art and

8) the breadth of the claims

The instant specification fails to provide guidance that would allow the skilled artisan background sufficient to practice that instant invention without resorting to undue experimentation in view of further discussion below.

The nature of the invention, state of the prior art, relative skill of those in the art and the predictability of the art

Claims 1, 14 and 15 are directed to compounds that are 5-phosphodiaesterase inhibitors. The instant claims cover all compounds having pharmaceutical property of being known as a compound (5-phosphodiaesterase inhibitor).

The instant claims are very broad. For instance, claims 1 and 15 are to a plethora of compounds of as described by the functional properties as being known as 5-phosphodiaesterase inhibitors.

The relative skill of those in the art is generally that of a Ph.D. or M.D.

One skilled in the art would not predict from the instant disclosure which compounds would fall under the umbrella of functional description of being known as broadly as a 5-phosphodiaesterase inhibitor. In fact, the courts have made a distinction between mechanical elements function the same in different circumstances, yielding predictable results, chemical and biological compounds often react unpredictably under different circumstances.

The breadth of the claims

The claims are very broad and inclusive to all 5-phosphodiaesterase inhibitors.

The amount of direction or guidance provided and the presence or absence of working examples

No examples showing the combination of other 5-phosphodiaesterase inhibitors such as verdenafil and tadalafil.

The only working examples showing the instant topical sensitizing combination with a 5-phosphodiaesterase inhibitor is sildenafil.

The quantity of experimentation necessary

Applicants have failed to provide guidance as to how the skilled artisan would be able to extrapolate from the disclosure and examples provided to make and possibly use the claimed invention. The amount of guidance or direction needed to enable the invention is inversely related to the degree of predictability in the art. Thus, although a single embodiment may provide broad enablement in cases involving predictable factors, such as mechanical or electrical elements, in cases involving unpredictable factors, such as most chemical reactions and physiological activity,

more teaching or guidance is required. (In re Fischer, 427 F. 2d 839, 166 USPQ 24; Ex Parte Hitzeman, 9 USPQ 2d 1823).

The quantity of experimentation needed to be performed by one skilled in the art is yet another factor involved in the determining whether "undue experimentation" is required to make and use the instant invention. The test is not merely quantitative, since a considerable amount of experimentation is permissible, if its is merely routine, or of the specification in question provides a reasonable amount of guidance with respect to the direction in which the experimentation should proceed. For these reasons, one of ordinary skill in the art would be burdened with undue "painstaking experimentation study" to determine all the compounds or agents that are broadly known to possess the property of treating neurological disorders as described in this specification. In view of the information set forth supra, the instant disclosure is not seen to be sufficient to describe the use of any compound , which is regarded as the functional description of a compound (5-phosphodiaesterase inhibitors).

Therefore, undue experimentation would be required to practice the invention as it is claimed in its current scope.

Claims 1, 14 and 15 are not allowed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be

> patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson et al. (5,425,954) in view of Kaplan et al., "Safety and Efficacy of Sildenafil In Postmenopausal Women With Sexual Dysfunction", Urology, Vol. 53, No. 3, pp. 481-486 (Mar. 1999).

Thompson et al. teach a topical amino acid and vitamin composition for application to an epidermis, and further disclose the application of a stimulating

compound. The compound comprises a mixture of menthol and L-arginine; note the composition contains between 1-10% of arginine and between 0.1-1.0% of menthol (see Tables I and II).

The instant invention differs from the cited reference in that the cited reference does not teach addition of a 5-phosphodiaesterase inhibitor. However, the secondary reference, Kaplan et al., teaches sildenafil produce clitoral sensitivity (see the abstract).

Clearly, one skilled in the art would have assumed the combination of three individual agents well-known to produce a cooling and sensitizing effect on various epidermis areas into a single composition would give an additive effect in the absence of evidence to the contrary.

Claims 1, 14 and 15 are not allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin E. Weddington whose telephone number is (571)272-0587. The examiner can normally be reached on 12:30 pm-9:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on (571)272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Primary Examiner
Art Unit 1614

K. Weddington
April 9, 2007